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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|--------------------------|------------------|
| 10/603,534 | 06/25/2003 | Alexandre Bronstein | BRONSTEIN.001 | 4130 |
| 7590 | 01/11/2005 | | EXAMINER KHAN, SUHAIL | |
| PAUL HORSTMANN 706 TENTH STREET HERMOSA BEACH, CA 90254 | | | ART UNIT 2686 | PAPER NUMBER |

DATE MAILED: 01/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/603,534

Applicant(s)

BRONSTEIN, ALEXANDRE

Examiner

Suhail Khan

Art Unit

2686

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/25/2003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-6, 9-10 and 15-20 rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6650742 to Elliott et al.

Referring to claim 1, Elliott et al disclose a method for defense against an unwanted communication (col 1, lines 52-55, penalizing service, annoying voice call), comprising the steps of: identifying a communication channel to beneficiary of the unwanted communication (col 1, lines 56-60, identifies a caller); sending a communication via the communication channel to the beneficiary such that the communication imposes a cost to the beneficiary (col 1, lines 60-65, charge the caller).

Referring to claim 2, Elliott et al disclose the method of claim 1, wherein the step of sending: a communication via the communication channel to the beneficiary comprises the step of sending a communication via the communication channel that includes a request that the beneficiary cease further unwanted communications to a recipient of the unwanted communication (col 1, lines 52-55, penalizing service, it is inherent that the penalizing service is an indication that the recipient is asking the sender to cease further unwanted communication).

Referring to claim 3, Elliott et al disclose the method of claim 1, wherein the step of sending a communication via the communication channel to the beneficiary is performed repeatedly in accordance with a set of strike back parameters (col 1, lines 60-65, charge the caller; also, col 5, lines 50-55, fine is chosen).

Referring to claim 4, Elliott et al disclose a method of claim 3, further comprising the step of adjusting the cost by adjusting the strike back parameters (col 1, lines 60-65, charge the caller; also, col 5, lines 50-55, fine is chosen).

Referring to claim 5, Elliott et al disclose the method of claim 1, wherein the step of identifying comprises the step of identifying a communication channel used by the beneficiary to obtain a benefit (col 1, lines 56-60, identifies a caller).

Referring to claim 6, Elliott et al disclose the method of claim 1, wherein the step of identifying comprises the step of calling a phone number contained in the unwanted communication (col 4, lines 11-13, directory number corresponding to a voice call).

Referring to claim 9, Elliott et al disclose the method of claim 1, wherein the step of identifying comprises the step of performing a pattern match on a text of the unwanted communication (col 3, lines 10-14, predetermined set of conditions).

Referring to claim 10, Elliott et al disclose a defense coordinator (col 2, lines 28-33, SCP), comprising: database having a set of records each corresponding to a suspected abusive marketer (col 3, lines 34-37, databases); intelligence process (col 3, lines 7-10, intelligent network functionality) that identifies a communication channel to a beneficiary of an unwanted communication (col 5, lines 22-25, identify the last caller) and that records the communication

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channel in the record in the database that corresponds to the beneficiary (col 4, 11-15, caller ID field).

Referring to claim 15, Elliott et al disclose the defense coordinator (col 2, lines 28-33, SCP) of claim 10, wherein the intelligence process (col 3, lines 7-10, intelligent network functionality) determines a set of strike back parameters for the unwanted communication in response to a set of information contained in the record that corresponds to the beneficiary of the unwanted communication (col 1, lines 60-65, charge the caller; also, col 5, lines 50-55, fine is chosen).

Referring to claim 16, Elliott et al disclose the defense coordinator of claim 15, wherein the intelligence process sends the strike back parameters to a recipient of the unwanted communication (col 1, lines 60-65, charge the caller; also, col 5, lines 50-55, fine is chosen).

Referring to claim 17, Elliott et al disclose the defense coordinator of claim 15, wherein the defense coordinator strikes back against the beneficiary according to the strike back parameters (col 1, lines 60-65, charge the caller; also, col 5, lines 50-55, fine is chosen).

Referring to claim 18, Elliott et al disclose the defense coordinator of claim 15, wherein the strike back parameters are selected to provide an overall strike back against the beneficiary that is proportional to an overall magnitude of unwanted communications from the beneficiary (col 1, lines 60-65, charge the caller; also, col 5, lines 50-55, fine is chosen; strike back parameters can be sent every time unwanted communication is received, which means that strike back parameters are proportional to the magnitude of unwanted communications).

Referring to claim 19, Elliott et al disclose the defense coordinator of claim 15,

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wherein the strike back parameters specify a frequency and a total number of strikes (col 1, lines 60-65, charge the caller; also, col 5, lines 50-55, fine is chosen).

Referring to claim 20, Elliott et al disclose the defense coordinator of claim 15, wherein the intelligence process enables the beneficiary of the unwanted communication to stop any further strike backs by performing a manual operation (col 1, lines 52-55, penalizing service, it is inherent that the penalizing service is an indication that the recipient is asking the sender to cease further unwanted communication).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-8 and 11-14 rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6650742 to Elliot et al, in view of U.S. Patent App. No. 2002/0004800 to Kikuta et al.

Referring to claim 7, Elliot et al disclose the identifying method of claim 1 (col 1, lines 56-60, identifies a caller). Elliot et al do not disclose that the method comprises the step of accessing a website specified in the unwanted communication. However, Kikuta et al show website browsing (page 7, paragraph 109, browse a web site). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Elliot et al to show the step of identifying comprises the step of accessing a website specified in the unwanted communication, as taught by Kikuta et al, the motivation being directing the bill to the appropriate caller (Elliot et al, col 1, lines 61-65).

Referring to claim 8, Elliot et al disclose the identifying method of claim 7 (col 1, lines 56-60, identifies a caller). Elliot et al do not disclose the method comprises the step of exploring a web site specified in the unwanted communication to find a web page that is financially important to the beneficiary. However, Kikuta et al show website browsing (page 7, paragraph 109, browse a web site; it is also inherent that the website related to the unwanted communication will itself be or will contain information regarding the parent website which would be financially responsible). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Elliot et al to show the step of identifying comprises the step of exploring a web site specified in the unwanted communication to find a web page that is financially important to the beneficiary, as taught by Kikuta et al, the motivation being directing the bill to the appropriate caller (Elliot et al, col 1, lines 61-65).

Referring to claim 11, Elliot et al disclose the defense coordinator (col 2, lines 28-33, SCP) of claim 10 with the intelligence process (col 3, lines 7-10, intelligent network functionality). Elliot et al do not disclose that the intelligence process computes a hash of the unwanted communication and stores the hash in the record that corresponds to the beneficiary. However, Kikuta et al show creating a request key ID from the web site, generating a hash value and recording related information (page 7, paragraphs 112, 113 and 114). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Elliot et al to show that the defense coordinator with the intelligence process computes a hash of the unwanted communication and stores the hash in the record that corresponds to the beneficiary, as taught by Kikuta et al, the motivation being efficient information transfer and identification (abstract, Kikuta et al).

Referring to claim 12, Elliot et al disclose the defense coordinator of (col 2, lines 28-33, SCP) claim 11, wherein the intelligence process (col 3, lines 7-10, intelligent network functionality) identifies a communication channel to a beneficiary of a subsequent unwanted communication (col 1, lines 56-60, identifies a caller). Elliot et al do not disclose that this step is performed by computing a hash of the subsequent unwanted communication and comparing the hash of the subsequent unwanted communication to the hash stored in the records of the database. However, Kikuta et al show generating a hash value and checking it with previously stored information (page 7, paragraphs 113 and 115). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Elliot et al to show that the defense coordinator with the intelligence process computes a hash of the subsequent unwanted communication and comparing the hash of the subsequent unwanted communication to the hash stored in the records of the database, as taught by Kikuta et al, the motivation being efficient information transfer and identification (abstract, Kikuta et al).

Referring to claim 13, Elliot et al disclose the defense coordinator (col 2, lines 28-33, SCP) of claim 12, with the intelligence process (col 3, lines 7-10, intelligent network functionality). Elliot et al do not disclose that the intelligence process creates a new record in the database for the beneficiary of the subsequent unwanted communication if the hash of the subsequent unwanted communication does not match the records in the database. However, Kikuta et al show generating a hash value and storing it (page 7, paragraphs 113 and 117). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Elliot et al to show that the defense coordinator with the intelligence process create a new record in the database for the beneficiary of the subsequent unwanted

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communication if the hash of the subsequent unwanted communication does not match the records in the database, as taught by Kikuta et al, the motivation being efficient information transfer and identification (abstract, Kikuta et al).

Referring to claim 14, Elliot et al disclose the defense coordinator (col 2, lines 28-33, SCP) of claim 13, wherein the intelligence process (col 3, lines 7-10, intelligent network functionality) identifies the communication channel to the beneficiary the subsequent unwanted communication (col 1, lines 56-60, identifies a caller). Elliot et al do not disclose that this step is carried out by examining the unwanted communication and then stores the hash of the subsequent unwanted communication and the communication channel to the beneficiary of the subsequent unwanted communication in the new record. However, Kikuta et al show generating a hash value and storing it (page 7, paragraphs 113 and 115). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Elliot et al to show the defense coordinator with intelligence process identifies the communication channel to the beneficiary the subsequent unwanted communication by examining the unwanted communication and then stores the hash of the subsequent unwanted communication and the communication channel to the beneficiary of the subsequent unwanted communication in the new record, as taught by Kikuta et al, the motivation being efficient information transfer and identification (abstract, Kikuta et al).

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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The following patents are cited to further show the state of the art with respect to methods for reducing unwanted communication by imposing costs on senders:

U.S. Pat. No. 6353663 to Stevens et al

U.S. Pat. No. 6535592 to Snelgrove

U.S. Pat. No. 6782084 to Kondo et al

U.S. Pat. No. 6259779 to Council et al

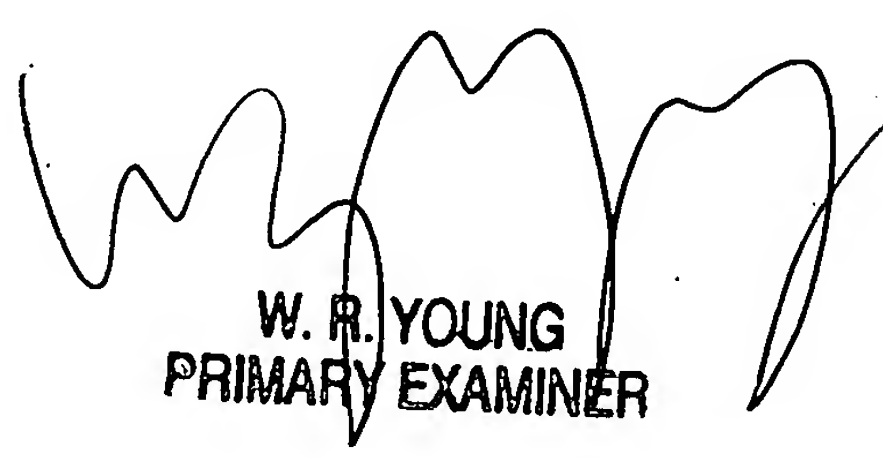
Pat. App. Pub. No. US 2002/0128033 to Burgess

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suhail Khan whose telephone number is (703) 305-8730. The examiner can normally be reached on M-F from 7:30 am to 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold, can be reached at (703) 305-4379. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

sk



W. R. YOUNG
PRIMARY EXAMINER